

REMARKS

Claims 1-28 are pending in the application. Claims 1, 20, 23 and 24 are amended by this Reply. Applicants respectfully submit that no new matter has been added by the amendments. Accordingly, Claims 1-28 are at issue.

Remarks Concerning the Amendments

Claim 1 has been amended to clarify that the step of "searching" performed in the method involves searching *for the identifiable information at a plurality of site addresses*. As the Examiner noted on pages 3-4 of the February 22, 2005 Office Action, the term "searching" could refer to two different scenarios. The amendment to Claim 1 is intended to clarify that the step of "searching" is performed by polling a plurality of addresses on the communications network, in search of the identifiable information associated with the factory automation product. Claim 1 has been further amended to include the step of *identifying the installation site address*, which is intended to clarify that prior to the step of searching the communications network, the installation site address of the factory automation product is not known to the monitoring mechanism. The Examiner's assumption that the installation site address is known to the monitoring mechanism (page 4 of the February 22, 2005 Office Action) is therefore not an accurate assumption.

Claim 20 has been amended to include a *means for searching over the communications network for an additional unit of the factory automation product which is used in violation of a product license*. That limitation was previously in Claims 23 and 24, the substance of which the Examiner has held allowable (page 8 of the February 22, 2005 Office Action). Applicants submit that Claim 20 is therefore in condition for allowance.

Dependent Claims 23 and 24 have been amended to no longer include the limitation *means for searching over the communications network for an additional unit of the factory automation product which is used in violation of a product license*, which has been incorporated

into Claim 20. Claims 23 and 24 have been so amended to avoid redundancy, because they depend on Claim 20 and therefore already include that limitation.

Applicants submit that the amendments made herein do not add any new subject matter to the application. Applicants further thank the Examiner for his comments and suggestions regarding the application, and submit that the amendments made herein are made in accordance with the Examiner's suggestions.

Remarks Concerning Rejections Under 35 U.S.C. § 112

In the May 6, 2004 Office Action, the Examiner rejected certain claims under 35 U.S.C. § 112 as failing to comply with the enablement requirement. In the Reply dated June 25, 2004, Applicants traversed that rejection. That rejection has not been reiterated in either the August 18, 2004 Office Action, or the February 22, 2005 Office Action. Applicants are proceeding under the assumption that those rejections have been withdrawn. Likewise, the Examiner has not raised any objections under 35 U.S.C. § 102, in any of the prior correspondence. Applicants thus turn directly to the rejections made under 35 U.S.C. § 103.

Remarks Concerning Rejections Under 35 U.S.C. § 103

Applicants respectfully submit that in light of the amendments made herein, the rejections made under 35 U.S.C. § 103 have been rendered moot, and should be withdrawn. On pages 4-5 of the February 22, 2005 Office Action, the Examiner rejected Claim 1 as being unpatentable over U.S. Patent No. 5,790,664 to Coley et al. ("Coley") in view of U.S. Patent No. 6,038,486 to Saitoh et al. ("Saitoh"). In light of the amendments made herein to Claim 1, Applicants respectfully traverse that rejection.

Claim 1 of the application is directed to a method for monitoring a factory automation product which is installed at an installation site having an installation site address on a communications network. The factory automation product is also associated with identifiable information, examples of which include "a product number, a product version, a serial number, or a Media Access Control (MAC) address" (Application, p. 2). Claim 1, as herein amended,

also requires the step of searching a plurality of site addresses on the communications network for the identifiable information. Neither Coley nor Saitoh disclose the step of step of searching a plurality of site addresses for the identifiable information.

Coley relates to a method for automatically tracking the use of software for determining whether the software is licensed. Coley does not include any teaching that the communications network is searched for identifiable information. In alleging that Coley *does* disclose that step, the Examiner has cited to the Coley patent (col. 8, ll. 38-42):

If a license is purchased via a homepage on the Web server 118, the Web server 118 can automatically update the database 112 with the information *supplied by the user or the computer* 100 (e.g. IP address *supplied in the context of a Web session*), thereby creating a valid license record. (emphasis added)

Applicants respectfully submit that the citation relied upon by the Examiner does not disclose *searching* the network for information as required by Claim 1. In fact, it teaches exactly the opposite: that the information is disclosed *to* the server *by the user or the computer*.

In the present invention, Claim 1 requires searching the network for such information. In sharp contrast, in Coley, such information is provided to the server without the need for a search. Moreover, as the Examiner has observed, Coley includes no teaching of a factory automation product (p. 5 of the February 22, 2005 Office Action).

Saitoh fails to cure the deficiencies of Coley. Saitoh relates to a method of operating, controlling, monitoring and analyzing the data of control devices. However, Saitoh does not teach the step of searching the communications network, either for the identifiable information or for the installation site address. The Examiner has alleged that "Saitoh clearly shows the ability to communicate over a network with equipment in a fashion well known in the art" (e.g., p. 6 of the February 22, 2005 Office Action). However, *communicating* with network equipment is not the same thing as *searching for* the equipment via the network.

Neither Coley nor Saitoh disclose the step of searching a plurality of site addresses on the network for the identifiable information. Applicants therefore respectfully submit that because neither Coley nor Saitoh disclose the elements of Claim 1, as amended, the § 103 rejection of Claim 1 based on those references should be withdrawn.

The Examiner has also rejected Claims 2-9 and 13-19 under § 103 based on the Coley and Saitoh references. Those claims are dependent claims stemming from Claim 1. Applicants submit that because Claim 1 is patentable over Coley and Saitoh, Claims 2-9 and 13-19 are patentable over those references as well.

On pages 3-4 of the February 22, 2005 Office Action, the Examiner also rejected Claim 20 as being unpatentable over the combination of Coley and Saitoh. On page 8 of that Office Action, the Examiner noted that Claims 23 and 24, which are dependent on Claim 20, are allowable. That allowable subject matter has been incorporated by amendment into Claim 20. Applicants now therefore respectfully submit that Claim 20 is in condition for allowance, in accordance with the Examiner's allowance of Claims 23 and 24.

Claims 21-28 are all dependent on Claim 20, and include all of its limitations. Applicants therefore submit that those claims are also patentable over the Coley and Saitoh references as well. Applicants therefore request that the § 103 rejection based on the Coley and Saitoh references be withdrawn.

Additionally, Applicants maintain that the combination of the Coley and Saitoh references is improper because there is no motivation or incentive in the prior art to combine those references in the manner suggested by the Examiner. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Examiner has alleged there is an incentive to combine the references because "one skilled in the art at the time the invention [sic] faced with the problem of software piracy of a factory automation software product (Saitoh) would have found it obvious to look to systems designed to be combined with any piece of software to produce this protection" (pp. 2-3, February 22, 2005 Office Action). However, even assuming that to be the case, *arguendo*, there is still no incentive to combine the *communication mechanism* of Coley with the factory objects of Saitoh. Applicants respectfully submit that the Examiner has established, if anything, only an incentive to combine the anti-piracy mechanism of Coley with the factory objects of Saitoh.

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There remains no incentive to combine the *communication mechanism* of Coley with the factory objects of Saitoh. In fact, as the Examiner has observed, Saitoh discloses its own communication mechanism (col. 1, ll. 44 et seq.; pp. 6-7 of the February 22, 2005 Office Action). Therefore, Saitoh actually teaches away from the combination of another communication mechanism such as that disclosed by Coley. Applicants therefore respectfully submit that there is no incentive to combine the references in the manner suggested by the Examiner, and request that the § 103 rejection based on the Coley and Saitoh references be withdrawn.


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Conclusion

In light of the remarks and amendments made herein, Applicants submit that Claims 1-28, as amended, are in condition for allowance. Applicants respectfully request the Examiner to withdraw the rejections and allow the claims to issue. If the Examiner has any questions regarding this Reply, he is invited to contact the undersigned. The Commissioner is authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herein.

Respectfully submitted,

Dated: May 19, 2005

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

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on May 19, 2005


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